

REMARKS

Claims 38-52 were pending in the subject application. By this Amendment, and in accordance with the Examiner's suggestions during the December 03, 2009 teleconference with Applicants representative, Mrs. Margaret Buck, Applicants have cancelled claims 38-52, and added new claims 53-68. Accordingly, upon entry of this amendment, claims 53-68 will be pending and under examination.

Support for the new claims can be found as stated in the first Preliminary Amendment filed on November 29, 2005, as well as follows.

Support for new claim 53 may be found in the specification, for example, on page 5, line 17 through page 6, line 20, page 4, line 8 through page 5, line 9, page 68, lines 19-21 and lines 30-33, page 69, lines 1-4, page 19, line 16-20, page 21, line 30-32.

Support for new claims 54-64 may be found in the specification, for example, on page 6, line 22 through page 12, line 26, page 19, line 16-20, page 21, line 30-32.

Support for new claims 65-68 may be found in the specification, for example, on page 3, line 22 through page 4, line 2, page 19, lines 16-20.

The new claims raise no issue of new matter, and Applicants respectfully request that the amendment be entered.

I. **REJECTION No. 2 (35 U.S.C. §112, First paragraph):**

On page 2 of the Office Action, the Examiner rejected claims 39, 40, and 43 under 35 U.S.C. §112, first paragraph, alleging that they fail to comply with the written description requirement. The Examiner alleges that the scope of the claims lack antecedent basis in the specification. The Examiner further alleges that on pages 12-19, the combination of R^5 being halogen, R^9 being halogen, and at least one R^1 - R^4 , R^6 - R^8 must not be hydrogen is not described, and concluded that the amended scope of claims 39, 40, and 43 is new matter.

Lastly, the Examiner notes that after removal of new matter and if the claims are restored to the previous version, i.e., previously cancelled claim 17, wherein R^1 - R^9 are optionally hydrogen... at least one of R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , R^7 , R^8 , and R^9 , is different from hydrogen), the rejections of record are maintained.

Merely in an attempt to advance the prosecution of the instant application, and without conceding the correctness of the Examiner's rejection, Applicants have cancelled claims 38-52 and added new claims 53-68. Applicants maintain that the scope of new claims 53-68 raise no issue of new matter and are properly supported by the specification as originally filed.

For example, support for new claim 53, which reads in part:

A compound of formula I...

...provided that at least two of R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , R^7 , R^8 , and R^9 is different from hydrogen;

or a pharmaceutically acceptable salt thereof.

can be found in the specification as previously stated above, as well as, for example, on page 68, lines 19-21 (Example 3d12) and lines 30-33 (Example 3d14), and page 69, lines 1-4 (Example 3d15). Clearly, by the present claim amendments, no new matter has been added.

Accordingly, Applicants respectfully request the Examiner reconsiders and withdraw this rejection.

II. REJECTION No. 4 (35 U.S.C. §102(e)):

On page 3 of the Office Action, the Examiner maintained the rejection of claims 39-51 under 35 U.S.C. §102(e) over Ruhland et al. US 7,138,407 (hereinafter "407"), US

7,144,884 (hereinafter "884"), or US 7,148,238 (hereinafter "238") (hereinafter the "Ruhland Patents") for the reasons of record.

Applicants note that claims 39-51 have been cancelled, and maintain that the Ruhland Patents do not anticipate new claims 53-68.

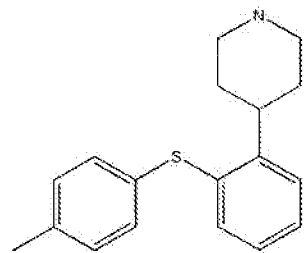
Applicants maintain that for prior art to anticipate the present invention, it must be a single piece of prior art that teaches each and every element of the claimed invention, and '407, '884, and '238 each fail to teach each and every aspect of the present invention. For example, new claim 53, reads in part:

A compound of formula I...

...provided that at least two of R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , R^7 , R^8 , and R^9 is different from hydrogen;

or a pharmaceutically acceptable salt thereof.

As noted by the Examiner in her Office Actions, the Ruhland Patents teach compound,



, and other where with respect to the scope of the genus covered by the present claims, only one of R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , R^7 , R^8 , and R^9 is different from hydrogen. That is to say, the Ruhland Patents teach compounds that are singly substituted with respect to the phenyl rings of its compounds.

Clearly, the Ruhland Patents **do not teach any** piperidine compound with at least two substitutions in the phenyl rings as does new claim 53 above; and thus do not anticipate the present invention.

Accordingly, the instant claims are novel, and applicants respectfully request the Examiner reconsider and withdraw this rejection.

III. REJECTION No. 6 (35 U.S.C. §103(a)):

On Page 3 of the Office Action, the Examiner rejected claims 39-52 under 35 U.S.C. §103(a) over US 6,699,864 for the reasons of record.

Applicants maintain that in light of the amendments to the claims, and the remarks made in response to Rejection No. 2 above, this rejection is moot and respectfully request that the Examiner reconsider and withdraw the rejection.

IV. REJECTION No. 5 (35 U.S.C. §103(a)):

On page 3 of the Office Action, the Examiner rejected claims 38-52 under 35 U.S.C. §103(a) over Ruhland '407, '884 and '238 for the reasons of record.

Applicants respectfully disagree and maintained that the previous response presented by Applicants is sufficient evidence to overcome this rejection. Applicants respectfully direct the Examiner's attention to the MPEP §706.02(1)(2)(II) (see page 700-59), which states that the statement previously provided by Applicants is sufficient evidence to establish common ownership.

Additionally, Applicants note that in accordance with Danish Law No 142 of 29 April, 1955, §5, a Danish employee has an obligation to assign the rights to an invention he has made to his/her employer.

Furthermore, Applicants maintain that even though the assignment of the instant case was recorded in October 2005, recordation of assignment is not a requirement for establishing ownership of an invention. See also, MPEP §706.02(1)(2)(II).

Accordingly, applicants respectfully request the Examiner reconsiders and withdraw this rejection.

V. REJECTION No. 8 (Requirement of Naming the First Inventive Entity):

Applicants maintain that in light of the remarks made in response to Rejection No. 5 above, this rejection is moot and respectfully request that the Examiner reconsider and withdraw the rejection.

VI. CONCLUSION

The Commissioner is hereby authorized to charge the aforementioned fees - \$1,110.00 for the Three-Months Extension of Time to Deposit Account No. 50-3201. No additional fee is deemed necessary in connection with the filing of this response. However, the Commissioner is further authorized to charge any additional fee or underpayment thereof, or credit any overpayment, to Deposit Account No. 50-3201, as necessary.

In view of the foregoing, Applicants submit that the instant application is in condition for allowance. An early Notice of Allowance is earnestly solicited. Applicants invite the Office to contact the undersigned to discuss any outstanding matters.

Respectfully submitted,

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